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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,395	06/24/2005	David Chow	285-237 PCT US	9017

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EXAMINER

WOODALL, NICHOLAS W

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/500,395

Applicant(s)

CHOW ET AL.

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 2-21, 24-35 and 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 22, 23 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06/28/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 2-21, 24-35, and 37-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/22/2006. The examiner agrees with the applicant that claim 36 reads on the elected invention and species and has been examined on the merits.

Information Disclosure Statement

2. The information disclosure statement filed 06/28/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The office has not received a copy of any of the foreign documents listed on the information disclosure statement.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference number 734 is not shown in the drawings. The examiner recommends that the applicant review the specification and the drawings for any additional missing reference numbers. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

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application. Any amended replacement drawing sheets should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

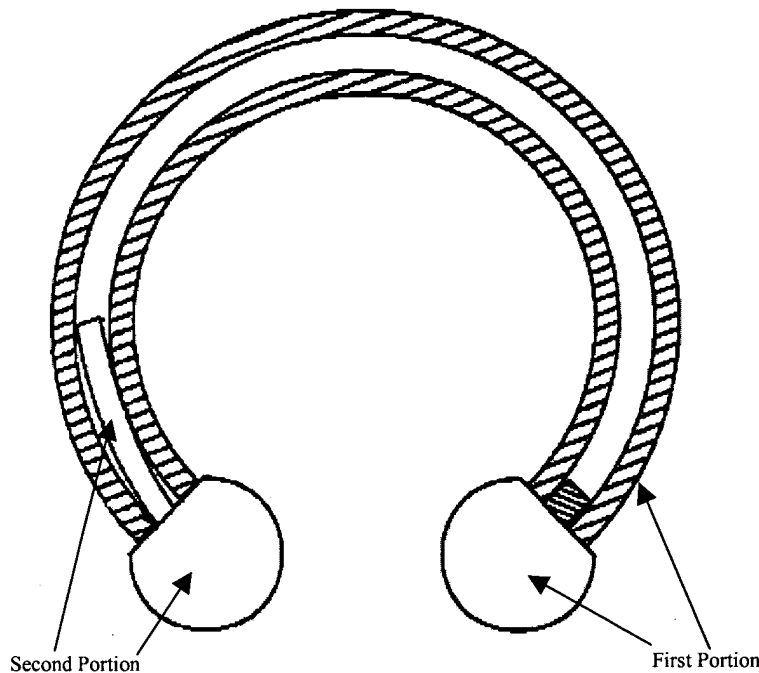
5. Claims 1 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Hochschuler (U.S. Patent 6,099,527).

Regarding claim 1, Hochschuler discloses a device comprising a first portion and a second portion displaceable relative to the first portion and detachably coupled therewith in a locked position. Regarding claim 36, Hochschuler discloses a device that can be inherently used by a method comprising the steps of displacing a first portion of the device through one of the bone fragments, displacing a second portion of the device through the bone fragments so as to engage the first and second portions of the device, and displacing the first and second engaged portions relative to one another to a locked position, wherein the bone fragments are secured by the locked device.

6. Claims 1, 22, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Siekierski (U.S. 6,470,709).

Regarding claim 1, Siekierski discloses a device comprising a first portion and a second portion displaceable relative to the first portion and detachably coupled therewith in a locked position (see Figure 1 below). Regarding claim 22, Siekierski discloses a device wherein the first and second portions each have curved cylindrical bodies dimensioned so that the cylindrical body of the second portion is slidably disposed within and extending through the cylindrical body of the first portion, a distal end of the second portion being enlarged to abut a distal end of the cylindrical body of the first portion. Regarding claim 23, Siekierski discloses a device wherein the proximal end of the cylindrical body of the first portion has an enlarged head capable of abutting an outer surface of bone fragments and wherein the distal end of the first body is capable of being forced outwards to abut an outer surface of another bone fragment in response to a tensile force applied to a proximal end of the second portion.

Figure 1



Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vagley (U.S. Patent 6,158,437) and Hochschuler et al. (U.S. Patent 6,099,527); Benderev et al. (U.S. Patent 6,200,633); Lalonde (U.S. Patent 6,315,780); and Brinson (U.S. 5,797,919) are cited as evidence.

Regarding claim 40, Vagley discloses a method of performing a surgical procedure wherein an instrument support tray is provided having a plurality of surgical

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instruments positioned thereon (column 1 lines 65-67). Vagley further discloses that the tray can be customized to cater to the preferences of a specific surgeon during a specific procedure and in such case may also provide additional equipment preferences of the surgeon. All this is directed toward enhanced efficiency in the surgical site and more accurate and prompt delivery of the correct instrument to the surgeon (column 5 lines 40-50). Vagley defines a surgical procedure as "a procedure performed on a patient by a physician, dentist, veterinarian, or other legally authorized health care professional in which the procedure involves a plurality of hand-held instruments and is at least partially invasive" (see column 3 lines 5-10). Hochschuler et al disclose that the kits or trays can include a two-piece bone fastener wherein the two pieces are locked together. Brinson discloses a tray or kit can include a bone clamp wherein a pair of jaws are pivotal relative to each other and can be locked using a locking mechanism. Benderev et al disclose a tray or kit can include a bone fastener manufactured from a shape memory material wherein at least one end has deformable webs that separate and engage an inner surface of the bone. Lalonde discloses a bone clamp wherein a pair of jaws are linearly displaceable relative to one another and can be locked using a locking mechanism. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place specific tools, such as fasteners and bone clamps, needed in a tray to cater to the preference of the surgeon during a specific procedure.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER